

Remarks

With entry of these amendments, claims 12-13 and 19-22 are pending in the application with claims 12 and 20 being independent claims. By the foregoing amendment, claims 19-22 are sought to be amended. These changes are believed not to introduce new matter and their entry is respectfully requested.

Rejections under 35 U.S.C. § 112

Claim 19 stands rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner asserts that the claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. In particular, the Examiner asserts that claim 19 claims a “wind-resistant material” for which there is no support in the original specification or disclosure.

In response thereto, Applicant has amended claim 19, replacing the wording “wind-resistant material” with “weatherproof material.” Applicant submits that the specification as-filed contains more than sufficient support for such wording. For example, some possible materials out of which apparatus 100 can be made are described as providing “protection from the elements.” Application, page 6, line 14. Furthermore, an embodiment of the invention provides a “weather barrier.” Application, page 2, line 7. In addition, the material used in an

embodiment of the invention is explicitly referred to as “weatherproof.” Application, page 3, line 2. Applicant therefore asserts that amended claim 19 has ample support in the original specification, and that the Examiner’s rejection of claim 19 under 35 U.S.C. § 112, first paragraph, has thus been rendered moot.

Claims 20-22 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, the Examiner asserts that claims 20-22 are not complete wherein the method step including the provision of the apparatus to insert the feet and legs therein has not been included prior to the step of inserting the legs therein. The Examiner further asserts that the inclusion of the fastener of claim 21 and materials of claims 22 and 23¹ does not further limit the method steps. The Examiner also asserts that in claim 21 there is no antecedent basis for “the wind-resistant material” in claim 12 as the term “wind-resistant” was not introduced until claim 19.

In response thereto, Applicant has amended claim 20 to include a step of obtaining a generally tubular length of material, as suggested by the Examiner. As claims 21-22 depend from claim 20, they necessarily include this step as well. Regarding the antecedent basis in claim 21, Applicant has replaced the reference to claim 12 with a reference to claim 19, as

¹Applicant believes that the Examiner may be referring to claims 20, 21, and 22, respectively, rather than claims 21, 22, and 23.

suggested by the Examiner. Applicant has also replaced “wind-resistant” in claim 21 with “weatherproof” so as to maintain consistent terminology with amended claim 19. Applicant asserts that the Examiner’s rejection of claims 20-22 under 35 U.S.C. § 112, second paragraph, has thus been rendered moot.

Rejection under 35 U.S.C. § 103

Claims 12, 13 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson (US 1,915,044) in view of Carson (US 4,893,586). The Examiner asserts that Anderson discloses an apparatus (A) for keeping a person warm including a generally tubular length of material (3) as seen in figures 1 and 2 (page 1, line 32) having an open end (at 7 in figures 1 and 2), a closed end (at 6 as seen in figures 1 and 2), an inner surface (as seen in figure 2), an outer surface (as seen in figures 1 and 2); an elastic band (7, seen in figures 1 and 2, described on page 1, lines 47-50), encircling the open end and a protective material 6 as seen in figures 1 and 2, described on page 1, lines 42-47) secured to the outer surface of the closed end of the apparatus. However, the Examiner concedes that Anderson does not specifically disclose the apparatus as including a fastener attached to the protective material. The Examiner states that the recitation “for securing the closed end of the apparatus to an external surface” has not been given any patentable weight since it does not further limit the structure of the fastener. The Examiner asserts that Carson discloses a tubular bag structure for keeping a user warm,

including a fastener, grommet 18 on the protective material of the bag 1 of Carson as seen in figure 1, to secure the bag/mat to a surface such as the ground 2 as desired during use. (See Carson, col. 2, lines 53-54; col. 1, lines 58-59). The Examiner asserts that it therefore would have been obvious to one having ordinary skill in the art at the time the invention was made to include a fastener, grommets 18 as described by Carson on the tubular apparatus of Anderson to secure the Anderson apparatus to a surface, such as the ground at an outdoor sports event, so that the member does not blow about and twist about the wearer. In regard to claim 13, Anderson discloses the pockets (8) located as claimed as seen in figures 1 and 2 and as described on page 1, line 95 - page 2, line 1. In regard to claim 19, the Examiner states that the material of the Anderson apparatus is “wind resistant” as broadly claimed since a heavily knit material described on page 1, line 35 resists wind. In regard to claim 20, the Examiner asserts that Anderson discloses the method of keeping a wearer warm comprising the steps of inserting one or both feet and legs in the generally tubular length of material having an open end, closed end, inner and outer surface, elastic band, protective mat and fastener as claimed and as discussed above in regard to claim 12.

In response thereto, with regard to claims 12 and 20, Applicant asserts that neither Anderson nor Carson teaches or suggests a fastener attached to a protective mat. “To establish a *prima facie* case of obviousness . . . the prior art reference (or references when combined) must teach or suggest all the claim limitations.” MPEP § 706.02(j). Carson discloses grommets

on a pet sleeping bag; Carson does not disclose grommets attached to a protective mat. Carson's grommets are simply attached to the fabric of the pet sleeping bag. The fact that Carson discloses the use of grommets attached to a particular part of the Carson bag does not render obvious the use of fasteners on other parts of a pet sleeping bag. In sharp contrast to Carson, Applicant's claims 12 and 20 specify that a fastener is attached to a protective mat. This limitation simply is not taught or suggested by Carson or Anderson.

Additionally, the Examiner's asserted rationale of a motivation for using a fastener, namely "so that the member does not blow about and twist about the wearer," is nowhere taught or suggested by Anderson or Carson. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP § 2143.01. Carson states that an objective of the invention is "the provision of a pet sleeping bag which may be secured in place to a ground surface." Carson, Col. 1, Lines 58-59. Carson also states, "Grommets at 18 are for reception of stakes when the bag is used out-of-doors." However, nowhere does Carson indicate that the purpose of the grommets is to prevent the bag from "blow[ing] about and twist[ing] about the wearer," as suggested by the Examiner. Rather, the only problem that is mentioned by Carson that might be solved by the use of grommets is the problem of preventing bag slippage during entry of the animal (although Carson never states that this is the purpose of the grommets). Carson, Col. 1, Lines 34-36, 50-51. Anderson indicates that "the bag will tend to cling to the

body of the wearer instead of falling away therefrom.” Anderson, 2, Lines 5-7. There is therefor no need for the Anderson device to have a fastener “so that the member does not blow about and twist about the wearer,” as suggested by the Examiner. The Anderson device is already constructed such that it does not blow about and twist about the wearer, and therefore there is no suggestion or motivation by Anderson to use a fastener. Since there is no such teaching or suggestion in the prior art, claims 12 and 20 cannot be rendered obvious by the teachings of Anderson in view of Carson.

With regard to claim 13, Applicant notes that claim 13 depends from claim 12. As Applicant asserts that claim 12 is nonobvious with respect to Anderson in view of Carson, Applicant asserts that dependent claim 13 is also nonobvious with respect to Anderson in view of Carson.

Claims 21 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson in view of Carson as applied to claims 12, 13 and 20 above, and further in view of Hutto (US 5,630,439) or the Campmor New Year 2000 Catalog, page 4-Cherry tree Nylon/Polartec Snow Suit.

In regard to claims 21 and 22, the Examiner asserts that Anderson and Carson disclose the invention substantially as claimed. However, The Examiner concedes that they do not specifically disclose the material of the tubular apparatus as being the specific “wind resistant” materials as claimed and the inner and outer surface as being one of those listed. The Examiner

asserts, however, that it is well known to construct protective, weatherproof/resistant garments and protective gear of GORETEX such as disclosed by Hutton (col. 2, line 49) to protect a wearer from wet, damp and cold weather or of Nylon and POLARTEC fleece or layered combinations of those materials to achieve the desired warmth and protection from the elements. Accordingly the Examiner asserts that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the protective cover of Anderson to construct it of any well known protective materials to achieve a desired level of protection such as making it of GORETEX, POLARTEC fleece and/or nylon or combinations thereof. The Examiner further asserts that it is also within the skill of one of ordinary skill in the art to select a known material that has a known benefit in order to achieve that benefit of that known material when constructing an article such as when selecting the certain types of fabrics in the construction of the article above.

In response thereto, regarding claims 21 and 22, Applicant asserts that Anderson in view of Carson and Hutto or Campmor does not teach or suggest a fastener attached to a protective mat as specified in claim 12 from which claims 21 and 22 indirectly depend. As discussed above in relation to claims 12 and 20, Anderson in view of Carson does not teach or suggest a fastener attached to a protective mat. Furthermore, neither Hutto nor Campmor teach or suggest a fastener attached to a protective mat. Therefore, Applicant respectfully asserts that claims 21 and 22 are not rendered obvious by Anderson in view of Carson and Hutto or Campmor.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicant believes that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Response is respectfully requested.

Respectfully submitted,

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